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| 09/963,922      | 09/26/2001  | Neil D. Falconer     | 0112300-638         | 1274             |

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EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/963,922

Applicant(s)

FALCONER, NEIL D.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 26 September 2001.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-28 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The use of the trademarks TOTEM POLE (page 4, lines 8-10; page 5, lines 3-4), RED, WHITE & BLUE (page 4, line 11), DOUBLE DIAMOND (page 4, line 11, 14, 15 and 17), FIVE TIMES PAY (page 4, lines 19, 21, 22 and 25) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-12, 14 and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Manship et al. (US Patent No. 5,697,843).

Manship et al. disclose a gaming device having a primary game comprising a plurality of identical (Column 4, lines 48-52) reels with each set of reels having a plurality of reels (FIG 2) and each reel has identical sets of symbols (FIG 3 and Column 4, lines 48-52). A plurality of paylines are associated with the reels (FIG 2 and Abstract, lines 5-9). A display device is adapted to simultaneously display the reels (Abstract, lines 1-5 and FIG 1, reference 30). The display device is also adapted to enable the player to wager on predetermined combinations by

highlighting the paylines available (FIG 2). The player is enabled to make a wager on the paylines (Column 3, lines 56-59). This function is controlled by the processor (Column 4, lines 14-19). Furthermore, the processor is used to allow player to wager on paylines and evaluates each reel wagered on for winning combinations and provides payouts to the player based on the wager (Abstract, lines 9-19). The processor pays out the player when a winning combination of game elements appears in the array area of the display and the payout is based on the value associated with the combination and the amount bet by the player (Column 2, lines 63-67). The device further allows the reels to be spun when a positive credit total exists in the machine. The microprocessor monitors the buttons and alters the screen display depending on the buttons pushed (Column 4, lines 39-42). This button includes spin wheels (Column 3, line 63) and thus the processor will spin the wheels wagered on by the player if a positive wager exists. The processor is adapted to enable the player to wager on predetermined combination of symbols to occur on at least one of the paylines (Abstract, lines 5-19). The paylines include predetermined combination symbols in one, two, or all of the reels (Abstract, lines 5-9, FIG 2 and FIG 4A). The paylines also include a combination in just two of the reels being that All 4 Corners is declared as a winning combination (FIG 4B). Being horizontal, vertical, and diagonal, the paylines include wagers for one or a combination of the sets of reels (Abstract, lines 5-9 and Fig 2). The device also allows the player to wager on all of the said paylines (Column 5, lines 1-14). Inherently and as is notoriously well known in the art, the player may also wager on an individual payline.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6, 13, 21, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manship et al. (US Patent No. 5,697,843) in view of Nicastro et al. (US Patent No. 5,569,084).

What Manship et al. disclose has been discussed above and is incorporated herein.

While Manship et al. disclose a number of paytables (FIG 4A-4D) that allow the player to wager on predetermined combinations of symbols, it is not disclosed that Manship et al. allow the player to wager on the symbols not occurring on the paylines. It is very well known in the art, as well as disclosed by Nicastro et al., to allow players to wager on the fact that no symbols will occur on the paylines (FIG 4). By allowing players to wager on the fact, that no symbols will occur on the paylines, the players will feel a greater chance of winning, as it is well known that often the payline stops just between two symbols. Given the opportunity to win on such a stop, the players feel more excited to play the game as they feel that since it occurs so often, they

will have a greater chance of winning, if awarded for the payline not having symbols. For these reasons, one of ordinary skill in the art would be motivated to combine the teachings of Nicastro et al. into the paytables of Manship et al. to allow the player to wager on no symbols being present on the payline.

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Claims 7, 15-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manship et al. (US Patent No. 5,697,843).

What Manship et al. disclose has been discussed above and is incorporated herein.

Manship et al. disclose that a player is able to wager on up to eight paylines in the disclosed gaming device. Manship et al. does not detail exactly how the player can wager, but does disclose that the processor enables the player to wager on the paylines. Manship et al. does not explicitly state that upon activating all the paylines in a set of reels, the player can then wager on paylines in another set of reels. However, if the player desires to make a subsequent wager on more than one set of reel, which would be required to maximize all eight paylines, it would have been obvious to allow the player to wager on a next available set of reels in order to accommodate the eight paylines available and allow the player to maximize their bet.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,413,162:** Gaming device with a multiplicity of paylines and reels in which the user can bet on reels and sets of reels.

**US Patent No. 6,227,971:** A gaming device with a primary display that has a multiple line and multiple reels.

**US Patent No. 5,609,524:** A slot machine with a plurality of motors for rotating each of a separate slot reels in a plurality of sets and a multiplicity of paylines.

**US Patent No. 4,838,552:** Slot machine with CRT display where a player can wager on a variety of paylines from a set of reels, each with its own further set of reels.

**US Patent No. 5,584,764:** A slot machine with a 3x3 array forming the front panel with a multiplicity of sets of reels wherein there are multiple wagering schemes in which the player can wager.


**US Patent No. 4,874,173:** A slot machine with a wheel mechanism that rotates a plurality of display reels, each part of a set with identical indicia. A plurality of paylines are available for wagering.

**US Patent No. 5,704,835:** Electronic slot machine which allows a player to wager on a multiple number of paylines among a plurality of a set of reels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

  
cmm  
March 4, 2003

  
**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**